



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,857	11/16/2000	William L. Jansen	44439.1.8.1	5894
7590	12/08/2006		EXAMINER	
R Lewis Gable Cowan Liebowitz & Latman PC 1133 Avenue of the Americas New York, NY 10036-6799			VAN BRAMER, JOHN W	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 12/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/714,857	JANSEN ET AL.
	Examiner	Art Unit
	John Van Bramer	3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 26 September 2006.
- 2a) This action is FINAL. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,8,14,15,18,20,22,23 and 25 - 49 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,8,14,15,18,20,22,23 and 25 – 49 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. The amendment filed on September 26, 2006 has cancelled no claims. No claims were amended and Claims 38-49 have been added. Thus, the currently pending claims considered below are Claims 1, 8, 14, 15, 18, 20, 22, 23, and 25 – 49.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 49 rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. The claim indicates that steps b, c, d, and e of Claim 10 are performed. However, there is no claim 10 in the current application and Claim 48 from which Claim 49 depends only recites three different steps. The disclosure of the claimed steps is critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976).

Art Unit: 3622

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 38 recites the limitation "the one user" in step (f). There is insufficient antecedent basis for this limitation in the claim. The applicant has not claimed a user at any other point in the claim. The examiner suggests change the limitation "the one user" to read either "a user" or "the one vendor". The examiner has interpreted the limitation to read "the one vendor" for the purpose of prosecuting the claim.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1, 8, 14, 15, 18, 20, 22, 23, and 25 - 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Postrel (6,594,640).

Claim 1: Postrel discloses a computerized method of tracking and using first and second point-to-credit conversion rates to convert respectively a user's first and

second loyalty program award points to system-wide credits, said method comprising the steps of

- (a) Obtaining the number of loyalty program award points awarded to a user under the first and second loyalty programs, the first loyalty program points differing in value from the second loyalty program points; (Col 1, lines 14 – 29 and Col 3, lines 30 – 40 and 58 – 60)
- (b) Using the first and second point-to-credit conversion rates to convert respectively the user's first and second loyalty program award points into system-wide credits, each of the system-wide credits being of a common value; (Col 3, lines 30 – 40; Col 9, lines 10 – 12; and Col 10, lines 18 – 20)
- (c) Providing to the user on-line access to at least one vendor that provides discounts for its products and/or services based on the number of system-wide credits that a user has; (Col 7, lines 1 – 41)
- (d) Enabling the vendor to determine for each of its products and/or services the number of system-wide credits required for the user to select and acquire the selected one of the vendor's products and/or services, and the amount of the discount off of the price of the selected one of the products or services; (Col 7, lines 1 – 41) and
- (e) Enabling the vendor to apply the discount to the price of one of the products or services selected by the user if the user has accumulated at least the number of system-wide credits set by the vendor. (Col 7, lines 1 – 41)

Claim 8: Postrel discloses the method of claim 1 further comprising the step of updating the number of the user's system-wide credits after the purchase of a product and/or service by the user. (Col 6, lines 1 – 52 and Col 7, lines 25 – 41).

Claim 14: Postrel discloses the method of claim 1 further including the step of displaying the current number of the user's system-wide credits to the user. ((Col 8, line 65 through Col 9, line 1)

Claim 15: Postrel discloses the method of claim 1 further comprising the steps of updating the number of the points of at least one of the user's first and second loyalty programs. (Col 7, lines 25 – 41)

Claim 18: Postrel discloses the method of claim 33 including the further steps of providing the information regarding the products and/or services for sale to the user via communication with the one vendor of the products or services. (Col 7, lines 1 – 10)

Claim 20: Postrel discloses the method of claim 33 including the further step of allowing the user to register with at least one of the plurality of loyalty programs as a member via an on-line registration form. (Col 6, lines 10 – 12 and Col 8 lines 4 – 26)

Claim 22: Postrel discloses the method of claim 33 wherein the step of converting the user's award points into the system-wide credits comprises calculating from the user's award points in each of the first and second loyalty programs a proportionate number of the system-wide credits (conversion rate) (Col 9, lines 9 – 12 and Col 10, lines 18 – 20).

Claim 23: Postrel discloses a computerized system for managing a plurality of loyalty programs utilizing the internet to accumulate the award points issued by the plurality of loyalty programs and to redeem the award points for items as selected by a user, the award points of at least one of the plurality of loyalty programs differing in value from the award points of another loyalty program of the plurality, said system comprising:

- (a) Means for converting the user's award points issued by the plurality of loyalty programs into system-wise credit, each credit being of a common value; (common credits) (Col 3, lines 30 – 40; Col 9, lines 10 – 12; and Col 10, lines 18 – 20)
- (b) A credits database for storing the balance of each of the system-wide credits for each user associated with at least one of the plurality of loyalty programs; (reward exchange account) (Col 6, lines 1 – 52)
- (c) A first interactive communication means connected to said credits database; (Figure 5, and Col 5, lines 3 – 60)

- (d) A second interactive communication means connected to at least one of a plurality of vendors of items offered to the user to enable the user to select at least one of the items; (Figure 5 and Col 5, lines 3 – 60) and
- (e) Means for enabling the one vendor to access via said first interactive communication means at least one of the balances of the system-wide credits stored in said credits database, whereby the one vendor can control the number of the one user's balance of system-wide credits that is required to enable a transaction involving the acquiring of selected items offered to the one user. (Col 5, lines 3 – 60)

Claim 25: Postrel discloses the computerized system of claim 23 further comprising a plurality of interactive communication means connected to at least one of the plurality of vendors for distributing to the user the items offered for exchange by the one vendor. (Col 5, lines 3 – 50)

Claim 26: Postrel discloses the computerized method of claim 1, wherein the user is enabled to receive loyalty program award points from a selected one of the plurality of loyalty programs. (Col 7, lines 45 – 61)

Claim 27: Postrel discloses the computerized system of claim 23, wherein there is included means for enabling the user to select the number of system-wide credits from each of the loyalty programs and to redeem the items as selected by the user. (Col 7, line 1 through Col 8, line 3)

Claim 28: Postrel discloses the computerized system of claim 23, wherein there is included a plurality of loyalty program databases, each database associated with a corresponding one of the plurality of loyalty programs and includes a plurality of files, each file storing a point balance for a corresponding one of the users. (Col 7, line 1 through Col 8, line 3)

Claim 29: Postrel discloses the computerized system of claim 23, wherein the vendor is enabled to determine whether a user's transaction is eligible to be exchanged for system-wide credits. (Col 7, lines 1 – 41)

Claim 30: Postrel discloses the computerized system of claim 23, wherein there is included means for enabling each of the plurality of vendors to determine the number of system-wide credits for which an item is eligible to be exchanged. (Col 7, lines 1 – 41)

Claim 31: Postrel discloses the computerized system of claim 23, wherein there are means to enable the vendor to determine the number of system-wide credits that are required to achieve a desired discount for the user. (Col 7, lines 1 – 41)

Claim 32: Postrel discloses the computerized system of claim 23, wherein there is included a user terminal for displaying to the user the number of credits needed to satisfy a transaction proposed by the user. (Col 8, line 65 through Col 9, line 1)

Claim 33: Postrel discloses a computerized method of tracking and using first and second points-to-credits conversion rates to convert respectively a user's first and second loyalty points to system-wide credits, each system-wide credit being of a common value, whereby the user can select and request at least one item offered by at least one vendor, said method comprising the steps of

- (a) Obtaining the number of loyalty program award points awarded to a user under each of the first and second loyalty programs, the first loyalty program points differing in value from the second loyalty program points; (Abstract, Figure 5, Col 1, lines 14 – 29, and Col 3, lines 30 – 40 and 58 – 60)
- (b) Using the first and second points-to-credit conversion rates to convert respectively the user's first and second loyalty program award points to system-wide credits; (Abstract, Figure 5, Col 1, lines 14 – 29, and Col 3, lines 30 – 40 and 58 – 60)
- (c) Transmitting to the one vendor a request from the user for the one requested item; (Col 7, lines 1 – 41) and
- (d) Enabling the one vendor in its sole discretion to respond to the item request to determine the amount of a discount from the cost of the requested item independent of the number of system-wide credits accumulated by the user. (Col 7, lines 1 – 41)

Claim 34: Postrel discloses the method of claim 33; further comprising the step of enabling the one vendor to determine for each of its items the predetermined number of system-wide credits required to permission the user to request the corresponding item. (Col 7, lines 1 – 41)

Claim 35: Postrel discloses the method of claim 34, further comprising the step of enabling the one vendor in it sole judgment to set the predetermined number of system-wide credits required to permission the user to request the corresponding item. (Col 7, lines 1 – 41)

Claim 36: Postrel discloses the method of claim 35, further comprising the step of enabling the vendor to access the number of system-wide credits accumulated by the user and, if the number of system-wide credits accumulated by the user is not less than the predetermined number of system-wide credits, permissioning the one vendor to enable the user to transmit to the one vendor the user's request for the corresponding item. (Col 7, lines 1 – 41)

Claim 37: Postrel discloses the method of claim 36, further comprising the step of applying the predetermined discount to the price of the one item selected by the user. (Col 10, lines 37 – 44)

Claim 38. Postrel discloses a computerized method of tracking and awarding points of at least one loyalty point program to a member of the one loyalty point program, said method comprising the steps of:

- a) Determining the total number of points awarded to the one member of the one loyalty point program. (Col 8, line 65 through Col 9, line 21)
- b) Converting the total number of points awarded to a credit. (Col 8, line 65 through Col 9, line 21)
- c) Providing the member access over a communications network to at least one vendor offering for sale at a discount at least one item having a predetermined price. (Col 9, lines 22-44)
- d) Enabling the vendor in its sole discretion to set the discount for its one item. (Col 10, lines 36-58)
- e) Applying the discount to the predetermined price to provide a discounted price for the one item. (Col 10, lines 36-58)
- f) Rendering the one user eligible to sell the one item if the credit is greater than the discounted price of the one item. (Col 9, lines 22-44) (The term user is interpreted to be the Merchant. Should the applicant mean that the consumer is the user then the claim would have been retractable by original presentation based upon the originally filed claims.)

Claim 39. Postrel discloses the method of tracking and awarding points as claimed in claim 38, wherein the credit comprises the value of the total number of points awarded to the one member. (Col 8, line 65 through Col 9, line 21)

Claim 40. Postrel discloses the method of tracking and awarding points as claimed in claim 38, wherein the discount is based on the credit. (Col 10, lines 36-58)

Claim 41. Postrel discloses the method of tracking and awarding points as claimed in claim 38, wherein the step b) of converting the user's awarded points into the credit comprises the sub step of calculating from the user's awarded points of the one loyalty program a proportionate number of a system-wide credit. (Col 3, lines 30 – 40; Col 8, line 65 through Col 9, line 21; and Col 10, lines 18 – 20)

Claim 42. Postrel discloses the method of tracking and awarding points as claimed in claim 38, wherein the step b) of converting the user's awarded points into the credit includes the sub step of converting the user's awarded points into each of a plurality of loyalty programs. (Col 10, lines 59-67)

Claim 43. Postrel discloses the method of tracking and awarding points as claimed in claim 38, wherein there is included a plurality of loyalty point programs, each of which awards points to the member. (Col 6, lines 1-52)

Claim 44. Postrel discloses the method of tracking and awarding points as claimed in claim 43, wherein said step of determining the number of points awarded to the member from at least one loyalty program includes the sub step of determining the number of award points awarded under each loyalty program. (Col 9, lines 39-64)

Claim 45. Postrel discloses the method of tracking and awarding points as claimed in claim 38, wherein there is further included the steps of determining if the member is eligible, the member selects the item to be purchased and a message is transmitted over the communications network to the one loyalty program to effect the redemption of the item discounted price. (Col 8, line 65 through Col 9, line 44)

Claim 46. Postrel discloses the method of tracking and awarding points as claimed in claim 38, wherein step b) comprises a sub step of converting the member's awarded points from a plurality of loyalty programs of the member. (Col 7, lines 1-41)

Claim 47. Postrel discloses a computerized method of determining whether a user is eligible to be awarded first and second loyalty points from at least first and second loyalty point programs respectively, the value of the first points differs from the value of the second points, the user being a member of both of the first and second loyalty point programs, a vendor offering for sale various items, each of the plurality of items having a predetermined price, said method comprising the steps of:

- a) Providing the user access over a communications network to a vendor to select at least one of the pluralities of items and determining the item's predetermined price. (Col 8, line 65 through Col 9, line 44)
- b) Selecting first the first loyalty program as a source of first points with which to purchase the selected item. (Col 7, lines 1-41, and Col 10, 18-20)
- c) Converting the selected first points to system points and determining the first value of the converted system points. (Col 7, lines 1 through Col 8, line 3; and Col 10, 18-20)
- d) Determining the eligibility of the user to receive the selected item to be purchased by the user by comparing the predetermined price of the selected item with the value of the system points and, if the value of the system points is greater than the predetermined price of the selected item, proceed to purchase the selected item for the user. (Col 9, lines 22-44)
- e) If the value of the system points is less than the price of the selected item, selecting second the second loyalty point program as a source of second points

with which to purchase the selected first item. (Col 7, lines 1 through Col 8, line 3)

Claim 48. Postrel discloses the computerized method of determining as claimed in claim 47, wherein there is further included the steps of:

- a) Converting the selected second points to system points and determines the value of the converted system points. (Col 7, lines 1 through Col 8, line 3; and Col 8, line 65 through Col 9, line 21)
- b) Adding the first and second values of points to provide a composite point value. (Col 7, lines 1 through Col 8, line 3)
- c) Determining again the eligibility of the user to receive the selected item to be purchased by the user by comparing the predetermined price of the selected item with the composite point value and, if the composite point value is greater than the predetermined price of the selected item, proceed to purchase the selected item for the user. (Col 7, lines 1 through Col 8, line 3)

Claim 49. Postrel discloses the computerized method of determining as claimed in claim 48, wherein if the composite point value is less than the predetermined price of the item, proceed to repeat steps b, c, d and e of claim 10, until there are no further loyalty point program to be selected as a source of points with which to purchase the selected item. (Col 7, lines 1 through Col 8, line 3)

Response to Arguments

8. Applicant's arguments filed September 26, 2006 have been fully considered but they are not persuasive.
 - a. Applicant's arguments do not comply with 37 CFR 1.111(c) because they do not clearly point out the patentable novelty which he or she thinks the claims present in view of the state of the art disclosed by the references cited or the objections made. Further, they do not show how the amendments avoid such references or objections. The applicant argues that system wide credits and multiple loyalty programs of different clause are not taught by the Postrel reference, even though the examiner has cited relevant teaching within the Postrel reference that teach the use of system wide credits and multiple loyalty programs in the rejection and response to arguments of the Office Actions dated July 20, 2005 and April 23, 2006. The applicant asserts that the teaching of a plurality of independent loyalty point programs does not discloses that these loyalty programs are of different values. However, Col 5, lines 12-16, specifically describe two separate programs that determine points in two separate manners one based upon purchases and one bask on selecting advertising. Postrel further discloses converting these different points into a system wide "reward exchange account" in Col 7, lines 1-41. Additionally, a conversion value is applied to the points in Col 9, lines 5-21. If the points in the separate loyalty programs were not of different values, no conversion value would be necessary.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Van Bramer whose telephone number is (571) 272-8198. The examiner can normally be reached on 6am - 4pm Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3622

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

jvb



ERIC W. STAMBER
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600